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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,627	09/21/2001	Daniel R. Potter	005127.00062	4285

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EXAMINER	
STASHICK, ANTHONY D	
ART UNIT	**PAPER NUMBER**
3728	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,627	POTTER	
	Examiner	Art Unit	
	Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *58-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *58-80* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 September 0201* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 58-59, 61-65, 71-73, 76-77 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 91/10376 (WO '376) in view of Gilbert 2,080,469 or EP 215,974. WO '376 discloses all the limitations of the claims including the following: resilient sealed bladder 30, 22 for containing fluid (no fluid escapes and the bladder is not "breathing", i.e. allowing air to enter the bladder from outside the shoe upon lifting of the foot and exit the bladder and shoe upon placing the weight of the user's foot upon the bladder); the bladder having a sole portion 30 adapted to be received by an opening 38 in the sole assembly; the bladder adapted to be positioned generally horizontally underneath a portion of the wearer's foot (30 placed within 38); a foot portion 22 extending generally vertically from the sole portion (see Figure 4); the foot

portion adapted to be positioned to a side edge of a wearer's foot (see Figure 1); the sole and foot portion adapted to be positioned at a metatarsal region of a wearer's foot (see Figure 1); the sole and foot portion forming an L-shaped bladder (see Figure 4); the foot portion in fluid communication and integral with the sole portion (see Figure 4) wherein compression on the sole portion increases fluid pressure in the foot portion (only place for fluid to move to if compressed in foot portion); the sole portion of the bladder is thicker than the foot portion (see Figure 4); the sole portion is generally rectangular shaped (as seen in Figure 4); the foot portion is generally trapezoidal shaped (see Figure s 1 and 4, from side, 22 is trapezoidal in shape); the resilient bladder has a channel within it (that where fluid flows); the initial fluid pressure of the bladder is above ambient pressure (see page 5, lines 10-11, pressurizing the bladder with fluid, i.e. above ambient pressure); upper connected to sole assembly thereby defining a volume for receipt of user's foot (see Figure 1); compensating means is the bladders with the sole portion being underneath a wearer's foot and adjacent the lateral or medial side edge ; the bladder being sealed (see sealed portion noted above) with a sole and integral foot portion 22, 30; the foot portion of bladder positioned adjacent lateral or medial side edge of sole

(see Figure 4); opening in sole 38; midsole having contour and sole portion having surface generally flush with midsole contour (see Figure 1 for midsole and outer sole); bladder has outer surface generally flush with the lateral or medial side of the midsole (see Figure 4 and 1, 34 fits 42 with 22 flush with outer surface of midsole); bladder has surface and article of footwear is adapted to visibly expose the surface to an exterior of the article of footwear (are which tongue covers); bladder has a surface portion that is at least translucent to allow for the interior to be visible from the exterior of the footwear (see page 2, line 25-page 3, line 8); the opening in the sole is adjacent the lateral or medial side edge (see Figure 4); the opening is positioned in the metatarsal region of the sole (see Figure 4); the foot portion of the bladder extends upwardly from the sole and has a top edge that tapers downward towards the front of the sole (See Figures 1 and 4); the sole portion of the bladder is thicker than the foot portion (see Figure 4); the foot portion 22 is located on the exterior of the upper (see Figure 1); the sole and foot portion are substantially perpendicular to each other (see Figures 1, 3, 4); the foot portion extends upwards from the sole portion (see Figures). WO '376 does not disclose the upper surface and the lower surface of the foot portion being bonded together. Gilbert '469 and EP

'974 each teach that the upper and lower surfaces of a bladder can be connected together to form non-inflatable spots (17 in Gilbert) or pinch points (21 in EP '974). These points are used to aid in inflating the bladder to the desired pressure as well as to add rigidity to the bladder to aid in giving support to the user's foot (see Gilbert, page 2, col. 1, lines 61-65 and col. 1, line 71 through col. 2, line 14. Also see EP '974 col. 5, lines 3-13, 37-52 and col. 7, lines 17-26.) Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the support bladder portions of WO '376 with non-inflatable spots or pinch points, as taught by Gilbert and EP '974, to aid in distributing the air throughout the bladder and aid in giving support to the bladder.

3. Claims 66-67 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 91,10376 in view of Gilbert 2,080,469 or EP 215,974, as applied above and further in view of Official Notice. WO '376 discloses all the limitations substantially as claimed including the following: an upper defining a void for receiving a foot of a wearer (see Figure 1); the upper having a medial and lateral side (see Figure 1); a sole assembly 12 secured to the upper; a sealed bladder 30, 22 that encloses a pressurized fluid; the bladder having a sole

portion 30 and an integral foot portion 22 in fluid communication; the sole portion being at least partially encapsulated within the sole assembly and positioned underneath the void (see Figure 4); the foot portion extending upward from the sole portion and along at least one of the medial side and the lateral side of the upper (see Figures 1 and 4); the thickness of the sole portion is greater than the thickness of the foot portion (see Figure 4); the sole portion and the foot portion are substantially perpendicular to each other (see Figure 4); a volume of the foot portion increases upon compressing the sole portion (typical operation of a bladder). Gilbert '469 and EP '974 each teach that the upper and lower surfaces of a bladder can be connected together to form non-inflatable spots (17 in Gilbert) or pinch points (21 in EP '974). These points are used to aid in inflating the bladder to the desired pressure as well as to add rigidity to the bladder to aid in giving support to the user's foot (see Gilbert, page 2, col. 1, lines 61-65 and col. 1, line 71 through col. 2, line 14. Also see EP '974 col. 5, lines 3-13, 37-52 and col. 7, lines 17-26.) Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the support bladder portions of WO '376 with non-inflatable spots or pinch points, as taught by Gilbert and EP '974, to aid

in distributing the air throughout the bladder and aid in giving support to the bladder. Neither WO '376 nor Gilbert or EP '974 discloses the sole assembly being made of a polymer foam material. Official Notice is taken that it is well known in the art to make sole out of polymer foam material such as polyurethane. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of WO '376, in view of Gilbert 2,080,469 or EP 215,974, out of a foam material such as polyurethane, to aid in cushioning the impact of the user's foot with the ground.

8. Claims 60, 68, 74-75 and 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 58, 66 and 71 above in view of Allen et al. 5,313,717. The references as applied to claims 58, 66 and 71 above disclose all the limitations of the claims except the sole portion of the bladder being thicker than the foot portion; the bladder having a channel for improving the flexibility and structural integrity of the bladder, and the limitations with respect to the recess in the top surface and the contacts. Allen et al. '717 teaches that a bladder used within a shoe sole can have a sole portion 34, 36 that is thicker than the foot portion 28 (made up of layer 36) to allow for better cushioning

of the user's foot with the impact of the shoe to the ground. Allen et al. '717 also teaches that channels can be recessed in the top surface of the bladder to control flow of the fluid (channels defined by clefts 52) with the channels running perpendicular to the foot section (see Figure 3). The sole has a bottom surface with a contact (clefts 52) that connects the bottom surface to the channels. These clefts are oval in shape (see Figure 3) with the channels extending to the inside surface of the foot portion. These clefts allow for the bladder to flex (see col. 6, lines 47-53). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place clefts defining channels or place the channels between the non-inflatable portions or pinch points, as taught by Allen et al. '717 in the bladder of the references as applied to claims 58, 66 and 71 above to allow for better fluid control and flexibility of the bladder with respect to the natural flexion of the user's foot.

Response to Arguments

4. Applicant's arguments filed February 16, 2004 have been fully considered but they are not persuasive. Applicant argues that none of the references applied disclose a bond between the first surface and second surface of a vertical bladder as

claimed. This argument is not clearly understood. Both Gilbert and Huang '974 teach the bonding between opposite sides of a bladder to break the bladder up into different sections. This bonding can occur whether the bladder is used horizontally or vertically, as the purpose is to separate the inside of the bladder into separate compartments. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to section the vertical bladder of Gilbert and Huang '974 for the purpose of sectioning the bladder into separate compartments to better control cushioning properties of the bladder. The applicant argues that the examiner selectively picked and chose from the prior art various elements to arrive at the claimed invention, i.e. hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this particular application, the bonding of the upper

and lower layers of a bladder was taught to be desirable in the prior art so that one would be able to shape and section portions of the bladder. Huang '974 teaches that the bonding of the upper al lower layer is desirable so that a self-supporting function can occur, i.e. the bladder can support itself in an upright position (see col. 5, lines 6-13 and 37-52). Gilbert specifically states that the bonds 17 can be used to create a device of great versatility in application, i.e. able to place the spots 17 where needed to give proper support, as well as a new way of making the device. Therefore, for these purposes alone, the references would be combinable as noted above and hindsight reasoning was not used. Applicant further argues that the PCT application contains tubular ducts that would be sealed if the bonds suggested by Gilbert or Huang '974 were used. This argument is not clearly understood. Gilbert clearly states that the bonds (spots 17) "may be made of any desirable size or shape" in col. 2, lines 71-73. Therefore, one of ordinary skill in the art can size the bonds so as not to close off the flow of air in the PCT application and still give the desired support to the user. Therefore, the rejections as set forth above are deemed proper.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D

Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Fee Increase Questions	(703) 305-5125
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Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
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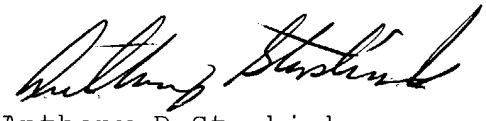

Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
May 17, 2004